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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,069	10/14/2000	Sai S. Subramaniam	16515.054	8450

7590 06/03/2003

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EXAMINER

KALLIS, RUSSELL

ART UNIT

PAPER NUMBER

1638

18

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/688,069	SUBRAMANIAM ET AL.
	Examiner Russell Kallis	Art Unit 1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 18 March 2003.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-45 is/are pending in the application.

4a) Of the above claim(s) 2-9 and 13-41 is/are withdrawn from consideration.

5) Claim(s) 43-45 is/are allowed.

6) Claim(s) 1 and 10 is/are rejected.

7) Claim(s) 11,12 and 42 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.                    6) Other:

### **DETAILED ACTION**

The rejection of Claims 10-12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of Applicant's amendments.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 10 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant asserts that description of a tocopherol cyclase from *Synechocystis* and a putative homologue of *Arabidopsis* defines the broad category of tocopherol cyclases that spans the groups encompassing all tocopherol cyclases from all organisms or all prokaryotic organisms (response page 4). The putative *Arabidopsis* tocopherol cyclase sequence of SEQ ID NO: 109, a sequence taken from a BAC clone, does not support the description of a genus of tocopherol cyclase encoding polynucleotides because the specification and the prior art do not show any correlation between the *Arabidopsis* BAC sequence and the *Synechocystis* sequence, and the claimed prokaryotic unifunctional tocopherol cyclase activity and thus, Applicant has described only one tocopherol cyclase.

Claims 1 and 10 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled

in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant asserts that the specification discloses how to make and use the claimed invention, including identifying tocopherol cyclase sequences, and that cells and plants have been transformed with the sequences of the present invention (response page 5). Applicant asserts that the Examiner has not indicated how the cited references of Broun, Doerks, or Smith suggest that such work would be undue experimentation (response page 6). The Examiner maintains that Applicant has not transformed plants with the *Arabidopsis* putative tocopherol cyclase gene, or evaluated the ability of this gene to either encode tocopherol cyclase or to restore tocopherol cyclase activity to knockout mutants. Applicant only transformed plants with *Arabidopsis* phytol prenyltransferase genes, which are non-elected. The references cited by the Examiner demonstrate the unpredictability inherent in <sup>assigning a biological function to an encoded</sup> gene product based solely on its similarity to other sequences. In the absence of a definite function, Applicant has not taught how to make and use the invention as broadly claimed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claims 11, 12, and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 43-45 are allowed.

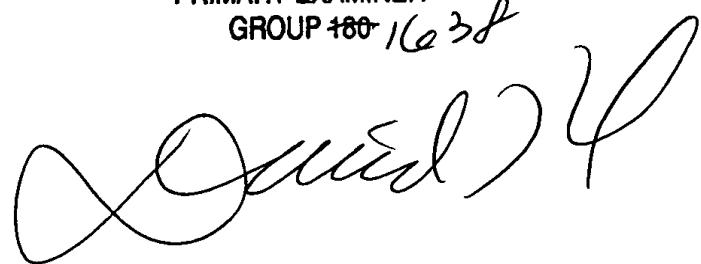
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (703) 305-5417. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Russell Kallis Ph.D.  
May 31, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 160-1638

A handwritten signature in black ink, appearing to read "David T. Fox". Above the signature, the text "DAVID T. FOX", "PRIMARY EXAMINER", and "GROUP 160-1638" is printed in a standard font.